

Appl. No. 10/776,354  
Reply to Office action of November 17, 2005

### Remarks

Applicant respectfully requests reconsideration of this application, as amended, and consideration of the following remarks.

### Amendments to the Claims

Applicants have amended the claims to more particularly point out what Applicants regard as the invention. Claims 1-17 remain in this application. Claims 1, 11, 16, and 17 have been amended. No new matter has been added as a result of the amendment. Support for the amendments can be found in figures 10 and 11 of the application.

### Rejections

#### *Rejections under 35 U.S.C. §112*

#### Claim 16

Claim 16 was rejected under 35 U.S.C. §112 as being indefinite with regard to the recitation of "its" in the claim. Claim 16 has been amended to eliminate the recitation of "its". Accordingly, Applicants submit that the invention as claimed in claim 16 as amended is not indefinite under 35 U.S.C. §112 and Applicants respectfully request withdrawal of the rejection of the claims under 35 U.S.C. §112.

#### *Rejections under 35 U.S.C. §102(b)*

#### Claims 1, 3, 5, 11-12, 15, and 17

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Claims 1, 3, 5, 11-12, 15, and 17 were rejected under 35 U.S.C. §102(b) as being anticipated by Mizuno et al., US 6,166,577. Applicants respectfully traverse the rejection because Mizuno does not teach each and every element of the invention as claimed in claims 1, 11, and 17 as amended and claims 3, 5, 12, and 15.

With regard to claims 1, 11, and 17 as amended, Mizuno does not teach **without using a clock signal** as recited in the claims as amended. Examiner points out to FIG. 4 of Mizuno and states in pertinent part that "CNT 1 monitors ... which compares the difference between S1 and CLK1". Applicants respectfully submit that one of ordinary skill in the art at the time of the invention would recognize that both S1 and CLK1 are clock signal which are required in the method disclosed in Mizuno. Accordingly, Applicants submit that the invention as claimed in claims 1, 11, and 17 as amended are not anticipated by Mizuno under 35 U.S.C. §102(b) and Applicants respectfully request withdrawal of the rejection of the claims under 35 U.S.C. §102(b).

Claims 3 and 5 depend from claim 1 and include all the limitations of claim 1, therefore are not anticipated by Mizuno for the same reasons as claim 1 as amended. Claims 12 and 15 depend from claim 11 and include all the limitations of claim 11, therefore are not anticipated by Mizuno for the same reasons as claim 11 as amended. Applicants respectfully request withdrawal of the rejection of the claims 3, 5, 12, and 15 under 35 U.S.C. §102(b).

Claims 1, 7-10, 11, 14, and 16

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Claims 1, 7-10, 11, 14, and 16 were rejected under 35 U.S.C. §102(b) as being anticipated by Miyazaki et al., US 6,489,833. Applicants respectfully traverse the rejection because Mizuno does not teach each and every element of the invention as claimed in claims 1, 11, and 16 as amended and claims 7-10 and 14.

With regard to claims 1, 11, and 16 as amended, Miyazaki does not teach **without using a clock signal** as recited in the claims. Examiner points out to FIG. 2 of Miyazaki and states in pertinent part that "CMP01 monitors ... by receiving inputs of inv01 and CLK02 ...". Applicants respectfully submit that one of ordinary skill in the art at the time of the invention would recognize that CLK02 is clock signal which is required in the method disclosed in Miyazaki. Accordingly, Applicants submit that the invention as claimed in claims 1, 11, and 16 as amended are not anticipated by Miyazaki under 35 U.S.C. §102(b) and Applicants respectfully request withdrawal of the rejection of the claims under 35 U.S.C. §102(b).

Claims 7-10 depend from claim 1 and include all the limitations of claim 1, therefore are not anticipated by Miyazaki for the same reasons as claim 1 as amended. Claim 14 depends from claim 11 and includes all the limitations of claim 11, therefore is not anticipated by Miyazaki for the same reasons as claim 11 as amended. Applicants respectfully request withdrawal of the rejection of the claims 7-10 and 14 under 35 U.S.C. §102(b).

*Rejections under 35 U.S.C. §103(a)*

Claims 1, 7-10, 11, 14, and 16

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Claims 1, 7-10, 11, 14, and 16 were rejected under 35 U.S.C. §103(a) as being unpatentable over Tsunoda et al., US 6,654,305 in view of Mizuno et al., US 6,166,577. Applicants respectfully traverse the rejection because the combination of Tsunoda and Mizuno does not render the claimed invention obvious as claimed in claims 1, 11, and 16 as amended and claims 7-10, and 14.

With regard to claims 1, 11, and 16 as amended, the combination of Tsunoda and Mizuno does not teach **without using a clock signal** as recited in the claims. As explained above regarding the anticipation rejection, Mizuno fails to disclose **without using a clock signal** of claims 1, 11, and 16 as amended. The teachings of Tsunoda does not cure this deficiency. The combination cannot be interpreted to disclose the claimed element. Because the combination of references misses elements that provide capabilities not suggested by the prior art, the combination does not render the claimed invention obvious under 35 U.S.C. §103. Therefore, the combination cannot render obvious Applicants invention as claimed in claims 1, 11, and 16 as amended, and Applicants respectfully request withdrawal of the rejection of the claims under 35 U.S.C. §103(a) over the combination.

Claims 7 and 10 depend from claim 1 and include all the limitations of claim 1, therefore are not rendered obvious by the combination of Tsunoda and Mizuno for the same reasons as claim 1 as amended. Claims 14 depends from claim 11 and include all the limitations of claim 11, therefore are not rendered obvious by the combination of Tsunoda and Mizuno for the same reasons as claim 11 as amended. Applicants respectfully request

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withdrawal of the rejection of the claims 7, 10, and 14 under 35 U.S.C. §103(a) over the combination.

#### Claims 6

Claims 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over in view of Mizuno et al., US 6,166,577. Applicants respectfully traverse the rejection because the combination of various teachings of Mizuno does not render the claimed invention obvious as claimed in claim 6.

Claim 6 depends from claim 1 and includes all the limitations of claim 1. With regard to claim 1, the combination of various teachings of Mizuno does not teach **without using a clock signal** as recited in the claim. As explained above regarding the anticipation rejection, Mizuno fails to disclose **without using a clock signal** of claim 1 as amended. The various teachings of Mizuno do not cure this deficiency. The combination cannot be interpreted to disclose the claimed element. Because the combination of references misses elements that provide capabilities not suggested by the prior art, the combination does not render the claimed invention obvious under 35 U.S.C. §103. Therefore, the combination cannot render obvious Applicants invention as claimed in claim 1 as amended and the dependent claim 6, and Applicants respectfully request withdrawal of the rejection of the claim 6 under 35 U.S.C. §103(a) over the combination.

#### Claims 2, 4, and 13

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Claims 2, 4, and 13 were rejected under 35 U.S.C. §103(a) as being unpatentable over Mizuno et al., US 6,166,577 in view of Dozza et al., US 6,292,400. Applicants respectfully traverse the rejection because the combination of Mizuno and Dozza does not render the claimed invention obvious as claimed in claims 2, 4, and 13.

Claims 2 and 4 depend from claim 1 and include all the limitations of claim 1. Claim 13 depends from claim 11 and includes all the limitations of claim 11. With regard to claim 1 and 11 as amended, the combination of Mizuno and Dozza do not teach **without using a clock signal** as recited in the claims. As explained above regarding the anticipation rejection, Mizuno fails to disclose **without using a clock signal** of claims 1 and 11 as amended. The teachings of Dozza does not cure this deficiency. The combination cannot be interpreted to disclose the claimed element. Because the combination of references misses elements that provide capabilities not suggested by the prior art, the combination does not render the claimed invention obvious under 35 U.S.C. §103. Therefore, the combination cannot render obvious Applicants invention as claimed in claims 1 and 11 as amended and dependent claims 2, 4, and 13, and Applicants respectfully request withdrawal of the rejection of the claims 2, 4, and 13 under 35 U.S.C. §103(a) over the combination.

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**Conclusion**

In view of the foregoing, Applicants believe that all of the claims 1-17 are now in condition for allowance and respectfully request the Examiner to issue a timely Notice of Allowance. If for any reason, the Examiner believes any of the claims are not in condition for allowance, he is encouraged to phone the undersigned at (650) 325-4999 so that any remaining issues may be resolved.

The above changes are believed not to add new matter, as support is found in the specification.

Respectfully submitted,



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